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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,627	07/02/2003	Trevor Nottage	F-8301	4061
24131	7590	11/26/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/612,627

Applicant(s)

NOTTAGE ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-22 are pending.

### ***Drawings***

2. The drawings submitted on 28 November 2003 have been made of record.

### ***Specification***

3. The abstract of the disclosure is objected to because it is too long. Current US practice call for an abstract containing 150 words, or 15 lines, or less.

Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. In claim 3, what does "disposed in said body material" mean? Is the luminescent material part of the composition from which the container is made?

Please clarify the claim.

7. In claim 6, what does "disposed within said body material" mean? Is the luminescent material part of the composition from which the container is made? Is the luminescent material inside the container?

Please clarify the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Monkarsh et al (US 2002/0119294A1; filed 28 February 2001).

Monkarsh teaches light-emitting, heat shrunk labels for containers (abstract).

The containers hold beverages (par. 0002). The labels are marked with phosphorescent ink (par. 0027).

The examiner deems phosphorescent compounds to be the same as luminescent ones.

10. Claims 1, 2, 4, 5, 7, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudnick (US 4,708,817).

Dudnick teaches decorative indicia containing fluorescent, luminescent or phosphorescent compositions (col. 2, lines 12-26). The indicia can be applied to containers to label their contents, as suggested by putting "poison" on a container (see col. 3, lines 45-57). The substrate to be used is plastic (col. 3, line 59) or paper (col. 4, line 12). The label on the container is visible in darkness (col. 3, lines 56-57).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-05173487A (abstract), hereafter "the '487 abstract", in view of Monkarsch.

The '487 abstract teaches adhesive labels for plastic, glass, paper and aluminum beverage containers (use/advantage section).

It is well known that aluminum is a metal.

The abstract fails to teach the use of luminescent materials in its labels.

Monkarsch is discussed above.

The references are analogous because they both teach labels for beverage containers.

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It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the labels of Monkarsch on the containers of the '487 abstract in order to render the containers light-emitting.

The motivation to employ the labels of Monkarsch on the containers of the '487 abstract is found in the Monkarsch abstract, where the light-emitting properties of its labels are taught.

It is deemed desirable to make containers light-emitting in order to make them easy to find in the dark.

14. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US 6,158,612) in view of Monkarsch or Dudnick.

Alpert teaches an indicia-bearing sleeve for a container (abstract; Figure 1). The sleeve is made of plastic, insulating foam (col. 2, lines 20-25). The sleeve provides insulation and visible indicia (col. 2, lines 23-25).

Alpert fails to teach light-emitting/luminescent indicia.

Monkarsch and Dudnick are discussed above.

The references are analogous because they all deal with containers and indicia therefor.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the indicia/labels of Dudnick or Monkarsch on the sleeves of Alpert in order to render the containers light-emitting/visible in darkness.

The motivation to use Dudnick's indicia on Alpert's sleeve is found at col. 3, lines 55-57 of Dudnick, where containers labeled "poison" are said to be visible in darkness.

The motivation to use Monkarsh's labels on Alpert's sleeve is found in Monkarsh's abstract, where its labels are said to light-emitting.

It is deemed desirable to make sleeves for containers that are visible in darkness or light-emitting in order to make it easier to find the containers in low-light situations, such as after sundown.

***Citations as of Interest***

15. US 6,305,817 (to Johnston) and JP 2000255147A (abstract only) are cited for teaching, respectively, battery-powered illuminated container holders and packages printed with fluorescent inks.

***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S. M. Nolan-Rayford*  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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